

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner continues to reject claims 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,843,789 to Goble (hereinafter "Goble").

In the previous response, Applicants made the following clarification to claims 17 and 18:

"determining subject tissue by categorizing the subject tissue by detecting the maximal current value flowing to the subject tissue and comparing the time up to the maximal current value with a first threshold value, and comparing the maximum current value regarding the categorized subject tissue with a second threshold value;"

Applicants further argued that Goble does not disclose detecting a living body tissue by the combination of the time up to the maximum value and the maximum value. That is, Goble does not disclose how to perform control using the time up to a maximum value. Goble merely detects the time in place of detecting a parameter, such as volume. Goble merely detects a living body tissue based on the result of detecting time or volume.

In the response to arguments section of the present Office Action, the Examiner argues that such features are disclosed at column 24, lines 41-56 (in essence, the Examiner has repeated the arguments from the previous Official Action). Applicants again disagree and submit that in Goble, that there is no description as to how to control using the time up to the maximum value but merely indicates that it is possible to detect time in place of detecting parameters such as voltage etc. Hence, in accordance with Goble, it is

considered to be only possible to detect a living body tissue based on the results of detection of time or detect a living body tissue based on the results of detection of voltage.

However, in the interests of advancing prosecution, Applicants have again clarified claims 17 and 18 to clearly distinguish the same over the references. Specifically, independent claim 17 has been amended to recite an electric surgery method comprising:

- generating a high frequency power to treat living-body tissue including blood vessels;
- treating the living-body tissue based on the generated high frequency power;
- converting the high frequency power into intermittent output;
- subcategorizing diameters of blood vessels included in subject tissue by:
 - categorizing the blood vessels according to the diameters thereof by detecting the maximal current value flowing to the subject tissue and comparing the time up to the maximal current value with a first threshold value, and
 - comparing the maximum current value regarding the categorized blood vessels with a second threshold value; and
 - setting output values and the number of times of the intermittent output based on the results of the subcategorizing.

Similarly, independent claim 18 has been amended to recite an electric surgery method comprising:

- generating a high frequency power;
- treating living-body tissue including blood vessels based on the generated high frequency power;
- subcategorizing diameters of blood vessels included in subject tissue by:
 - categorizing the blood vessels according to diameters thereof by detecting the maximal current value flowing to the subject tissue and comparing the time up to the maximal current value with a first threshold value, and
 - comparing the maximum current value regarding the categorized blood vessels with a second threshold value;
 - setting output values and the number of times of intermittent output based on the results of the subcategorizing; and
 - controlling the generated high frequency power based on the settings.

The amendments to claims 17 and 18 are fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendments to independent claims 17 and 18.

The Applicants respectfully submit that in the methods of claims 17 and 18, that subject tissue is determined by categorizing the subject tissue by detecting the time up to the maximal current value and further pursuant to the maximum current value detected regarding the categorized subject, thereby making it possible to further categorize the diameters of blood vessels.

For instance, an embodiment in the present application shows an example in which blood vessels are subcategorized not into two but into three, i.e. a large-diameter blood vessel, a middle-diameter blood vessel and a small-diameter blood vessel by the different times up to the maximal current value while the threshold value that is compared with the maximal current value is made the same 1A(ampere).

Thus, claims 17 and 18 have been amended to clarify such characteristic features, i.e., to clarify that the diameters of the blood vessels can be subcategorized by categorizing by the time to the maximal current value and categorizing by the maximal current value. It also becomes possible, e.g., to categorize into three or more by making a comparison with the threshold values twice which results in a more highly precise categorizing.

With regard to the rejection of claims 17 and 18 under 35 U.S.C. § 102(b), an electric surgery method having the features discussed above and as recited in independent claims 17 and 18, is nowhere disclosed in Goble. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and

every element of the claimed invention, arranged as in the claim,"¹ independent claims 17 and 18 are not anticipated by Goble. Accordingly, independent claims 17 and 18 patentably distinguish over Goble and are allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 102(b).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).